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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,352	11/09/1999	DIMITRI KANEVSKY	YO999-411	7851

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RYAN, MASON & LEWIS, LLP
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FAIRFIELD, CT 06824

EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
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2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/437,352	KANEVSKY ET AL.	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/09/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 1, 16, 27, 38, 39, 42, 49, 52 and 55 have been amended.
4. Claims 1-58 are pending.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection based on Applicant's added limitations into the independent claims 1, 16, 27, 38, 39, 42, 49, 52 and 55.

Claim Rejections - 35 USC § 103

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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6. **Claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,793 B1 to Li et al. and further in view of U.S. Patent No. 5,757,916 to MacDoran et al.

In regards to claims 1, 5, 15-16, 26, 27, 37-39, 40-47, 49, and 50-57, Li discloses a system and a method for employing a user's fingerprint to authenticate a wireless communication. When a wireless communication is to be initiated, the central authentication system engages in a challenge-response authentication with the wireless phone using the stored fingerprint associated with the mobile identification number (MIN) (Li: Abstract). Li also discloses that biometric data other than fingerprints can be used such as a user's voice (Li:column 17, lines 29-35).

However Li does not disclose a challenge response method that uses the location wherein said location is identified by utilizing a portable device assigned to said user.

MacDoran discloses that the state vector attributes distilled from the state vector observations supplied to the host authentication server define the location of the client, and that location is compared to the particular predefined location information for that client stored in the database. If the host authentication server produces a remote client location that matches that previously registered client location within a predetermined threshold, access is granted to the remote client user (MacDoran: column 24, lines 12-15).

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The present invention, alternatively, is directed to authenticating a user by confirming the location of the user utilizing, for example, a GPS device carried by the user. Thus MacDoran would require a single GPS device located at a client machine and the present invention would require, for example, a separate GPS device for each user of the client machine." MacDoran however discloses that the LSS device, whose function is to produce digitized state vectors, may exist in a PCMCIA card format for laptop computers for use in remote clients or mobile host server applications. It can also be configured into a single microchip for integration into original equipment manufactured products (MacDoran: column 15, lines 43-47, 58-59) which meets wherein said location is identified by utilizing a portable device assigned to said user. This allows each user to have a separate GPS device.

MacDoren discloses authentication a user or device by using various methods such as passwords, PIN's, smart cards, PCMCIA cards, and biometric authentication (MacDoren: column 1, lines 21-55). This meets the limitation of authenticating an individual person.

According to MPEP Section 2123 "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned.

They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331,1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275,277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551,554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection

since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.)."

Since MacDoren discloses that "the definition does not extend to individual users that operate an entity, because the invention does not have the ability to authenticate an individual person" (MacDoren: column 6, lines 59-65) this does not mean that creating a system that can authenticate an individual user is therefore not taught by MacDoren. MacDoren discloses the host authentication server produces a remote client location that matches the previously registered client location within a predetermined threshold, such as 3 meters, access is granted to the remote client user (MacDoren: column 24, lines 18-29).

MacDoren discloses using biometric authentication as a means to authenticate a user (MacDoren: column 1, lines 21-27, 50-55). MacDoren also discloses comparing the location of the client with the location stored in the database (MacDoren: column 24, lines 14-16). MacDoren discloses using biometric authentication such as finger and thumb prints, hand geometry, voice prints, retinal scans, and keystroke patterns (MacDoren: column 1, lines 50-55). In order to biometrically authenticate the user has to be present at the location of the transmitting device or else it would be impossible to accomplish any of the previously described biometric authentication techniques.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of using biometric data to authenticate wireless communications as disclosed by Li with the method of

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providing the location of the client and compared it to the stored location value and granting access to the user if the location is within a predetermined threshold as disclosed by MacDoran in order to make "spoofing" the host device very difficult (MacDoran: column 1, lines 15-16).

In regards to claim 2, Li discloses requesting a personal identification number (PIN) each time a call is made. This meets the limitation of a "password."

In regards to claims 3, 4, 10, 21, 32, Li does not disclose a pocket token or computer readable card.

MacDoran discloses using access tokens (MacDoran: column 1, lines 40, 49). This meets the limitation of "wherein said response is a computer readable card" or "pocket token."

It Would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the method of using access tokens as disclosed by MacDoran in order to determine whether a person or device attempting to access or perform a transaction with a host computer system is a person or device entitled to access, most host computer systems require the person or device to provide information confirming identity (MacDoran: column 1, lines 21-25).

In regards to claims 6-9, 11, 13, 17-20, 24, 28-31, and 35, Li does not however disclose using a global positioning system.

MacDoran discloses using a Global Position System (GPS) sensor to determine the location of the signature provided by the remote client. This meets the limitation of" wherein said global positioning system includes a local verification system."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the global positioning system as disclose by MacDoran in order to determine the location of an object or person with great precision and accuracy (MacDoran: column 5, lines 41-43).

7. **Claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,793 B1 to Li et al. in view of U.S. Patent No. 5,757,916 to MacDoran et al applied to claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57 above, and further in view of" Wireless Enhanced 9-1-1 Service - Making it a Reality," Bell Labs Technical Journal (Autumn 1996) by Meyer et al.

In regards to claims 12, 14, 23, 25, 34, 36, 48, and 58, Li does not disclose using 911 techniques or querying the user about something at the location of a requested device or facility.

Meyer however discloses asking the user of the cell phone "Do you have any more details on your location?" (Meyer: page 189, right column, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to combine the wireless cellular phone as disclosed by Li with the method of querying the user as to where they are because the existing E9-1-1 service was originally designed to support wireline calls from fixed locations (Meyer: page 188, right column, second paragraph).

In regards to claims 22 and 33 Li does not however disclose using triangulation.

Meyer however discloses that triangulation methods can be used (Meyer: page 198, left column).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the method of using triangulation as disclosed by Meyer because it can be implemented at a relatively low additional cost (Meyer: page 196, right column, third paragraph, last line).

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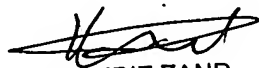
8. All claims are rejected. For the rejection of the claims, please see the Prior Final Rejection rendered on 12/06/2004 in light of BPAI DECISION ON APPEAL March 23, 2006; and further in light of Examiner rejection of added limitations into independent claims above.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is 571-272-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01/03/2007

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KAMBIZ ZAND
PRIMARY EXAMINER